

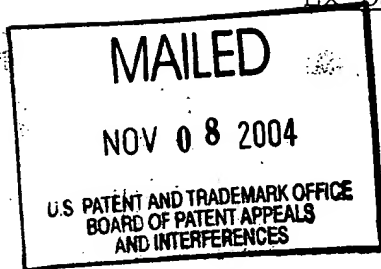
The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUMORU MATSUURA and YASUSHI YAMADE



Appeal No. 2004-1562
Application No. 09/437,499

ON BRIEF

Before THOMAS, HAIRSTON, and BARRETT, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 6, 9, 12 through 15 and 17 through 20. Claims 7, 8, 10, 11, 16 and 21 through 23 have been allowed.

The disclosed invention relates to an image forming apparatus that selectively sets which one of a plurality of trays receives discharged sheets bearing a formed image.

Appeal No. 2004-1562
Application No. 09/437,499

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An image forming apparatus comprising:

a plurality of trays for receiving discharged sheets bearing a formed image,

a setting means for selectively setting the form of output with respect to at least one of said plurality of trays, and

an image forming unit for forming an image on the sheets in the form of output set by said setting means when the tray which the form of output has been set is selected as the destination of discharged sheet.

The references relied on by the examiner are:

Taneda et al. (Taneda)	5,236,185	Aug. 17, 1993
Kida et al. (Kida)	5,852,764	Dec. 22, 1998
Matsui et al. (Matsui)	5,921,537	July 13, 1999

Claims 1 through 5, 9, 12 through 15, 17 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kida.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kida in view of Matsui.

Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kida in view of Taneda.

Reference is made to the brief (paper number 14) and the answer (paper number 15) for the respective positions of the appellants and the examiner.

Appeal No. 2004-1562
Application No. 09/437,499

OPINION

We have carefully considered the entire record before us, and we will sustain the anticipation rejection of claims 1 through 5, 9 and 17 through 20, reverse the anticipation rejection of claims 12 through 15, and sustain the obviousness rejections of claims 6, 18 and 19.

Turning first to the anticipation rejection, we will sustain the anticipation rejection of claims 1 through 5, 9 and 17 through 20 for all of the reasons expressed by the examiner (answer, pages 4, 6 and 7). In light of the examiner's findings, and the clear teachings of Kida (Figures 1 and 8; column 4, line 66 through column 5, line 3; column 18, line 65 through column 19, line 45), the appellants' arguments concerning claim 1 are completely without merit. Since Kida can selectively set either one of the copy, fax or printer mode buttons (Figure 8) to control the form of output or post handling condition (e.g., sheet reversal) of discharged sheets with respect to at least one of the plurality of trays 53 and 59 (Figure 1), we will sustain the anticipation rejection of claims 1 and 17. The anticipation rejection of claims 2 through 5, 9 and 18 through 20 is likewise sustained because appellants have chosen (brief, page 5) to let these claims stand or fall with claims 1 and 17.

Appeal No. 2004-1562
Application No. 09/437,499

Turning next to the anticipation rejection of claims 12 through 15, we agree with the appellants' argument (brief, pages 9 and 10) that Kida lacks "a setting means for selectively setting the size of a sheet." Kida merely teaches (column 28, lines 12 through 19; column 39, lines 43 through 52; column 43, lines 12 through 23) that the image forming apparatus is designed to operate on a sheet with a length of a minimum size. Thus, the anticipation rejection of claims 12 through 15 is reversed.

The obviousness rejections of claims 6, 18 and 19 are sustained because appellants have not presented any patentability arguments for these claims.

DECISION

The decision of the examiner rejecting claims 1 through 5, 9, 12 through 15, 17 and 20 under 35 U.S.C. § 102(e) is affirmed as to claims 1 through 5, 9, 17 and 20, and is reversed as to claims 12 through 15. The decision of the examiner rejecting claims 6, 18 and 19 under 35 U.S.C. § 103(a) is affirmed.

Appeal No. 2004-1562
Application No. 09/437,499

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

KWH/lp

Appeal No. 2004-1562
Application No. 09/437,499

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096